

Remarks

Reconsideration of the above-identified application in view of the present discussion is requested.

Claims 1-19 are pending in this application. Claims 14, 16, and 17-19 are withdrawn from consideration. Applicant reserves the right to file these claims in a continuing application. Claims 10, 12, 15, and 16 are rejected under 35 U.S.C. 112. Claims 1-13 and 15-16 are rejected under 35 U.S.C. 103(a).

Claim 1 is amended so that the preamble begins with the phrase "A method" instead of "The method." Claim 1 is further amended so that the step of "flooding the release surface of a release sheet" includes the result of this step as "to form a plurality of patches on the release sheet." The antecedent basis for this amendment is found on page 4, ll. 3-5 of the Specification. The second step of claim 1 is amended to read "applying a thermoplastic adhesive to the release sheet while the ink is still in the liquid stage." This amendment merely rephrases this step as originally filed. Finally, the word "thereafter" is removed from the final step of claim 1. Claim 1 is also amended to include the limitation "wherein the release sheet may be peeled away after the ink assumes the solid stage." The antecedent basis for this latter amendment is found on p. 5, ll. 26-27 of the Specification. Claim 6 is amended such that the phrase "step of" is inserted before the word "kiss cutting" and the phrase "with a laser is inserted after "laser cutting." Moreover, the phrase "the laser being supplied with sufficient power is inserted after "with a laser." These amendments merely clarify the claim as originally written. Claim 7 is amended to substitute "comprises" for "is made of." Similarly, claim 8 is amended to substitute "comprises" for "is." Claim 10 is amended to insert "plurality of" before the word "patches." This latter amendment is agreement with the "plurality of patches" of amended claim 1. Claim 12 is amended to replace "all of the discrete ink" with "the plurality of patches." No new matter has been added by these amendments.

A. Election/restrictions

Applicant hereby withdraws his traverse of the restriction requirement and elects claims 1-13, 15, and 16. Accordingly, Applicant withdraws claims 14 and 17-19.

B. Rejection Under 35 U.S.C. § 112

Claims 10, 12, 15, and 16 are rejected under 35 U.S.C. 112.

Claim 1 has been amended to include the phrase "to form a plurality of patches on the release sheet." This amendment removes the insufficient antecedent basis for the phrase "the patches" in claims 10, 15.

Claim 12 is amended to replace "all of the discrete ink" with "the plurality of patches" thereby removing the lack of antecedent basis for the phrases "all of the discrete ink patches."

Claim 16 is withdrawn thereby making the 112 rejection of this claim moot.

B. Rejection Under 35 U.S.C. § 103(a)

Claims 1, 2, 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl (U.S. Patent No. 5,667,614) in view of Abstract of CA 739923.

Stahl discloses a web having a transparent backing suitable for graphics transfer to a garment. The web has a release sheet of transparent polyester, a pigment layer coated, and a thermoplastic adhesive.

The Abstract of CA 739923 discloses "[t]wo thermoplastic sheets of wrapping material, e.g. for bread, are laminating by printing with ink on a surface of one sheet and

uniting the printed surface while the ink is still wet with the printable surface of another sheet, the sheets being bonded by the ink.” This abstract does not disclose a process or structure in which a thermoplastic adhesive is applied to a release sheet as used in the art of garment graphics printing. The structure of CA 739923 is obviously meant to laminate two plastic sheets together permanently. This is different from the function of a release sheet used in the graphics transfer art which is peeled away after a graphic has been applied to a garment. (Application p. 5, ll. 26-27.) Claim 1 is now amended to make this distinction clear by incorporating the limitation “wherein the release sheet may be peeled away after the ink assumes the solid stage.” Accordingly, the method of amended claim 1 (and its dependent claims) are patentable over the combination of Stahl and CA 739923.

Moreover, Abstract 739923 is non-analogous to the present invention. In accordance with *In Re Wood*:

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. . . . A reference is reasonably pertinent if . . . it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem. . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, . . . [i]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

In re Wood, 202 USPQ 171, 174 (C.C.P.A. 1979)

The Abstract of CA 739923 deals with lamination of plastic sheets to produce a laminated structure to be used in “wrapping” applications such as for bread. The present invention deals with processes for transferring graphics to clothing. Moreover, one skilled in the art of graphic to garment transfer would not look to the field of plastic lamination to solve the problem of applying an adhesive to a release sheet in which the release sheet is removed when

the graphics of the present invention are applied to a garment. As the Federal Circuit has explained:

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.

In re Oetiker, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992)

Accordingly, the combination of Stahl and the Abstract of CA 739923 does not establish a prima facie case of obviousness for independent claim 1 and its dependent claims 2, 4, and 5.

Claims 3, 7, 8, 10-12, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl (U.S. Patent No. 5,667,614) in view of Abstract of CA 739923, and in further view of Hubbard et al (U.S. Patent No. 4,466,994.)

For the same reasons as set forth above, Stahl and the Abstract of CA 739923 may not be combined together to establish a prima facie case of obviousness. Moreover, amended Claim 1 from which claims 3, 7, 8, 10-12, and 15 depend is further distinguished from Stahl and the Abstract by the incorporation of the limitation "wherein the release sheet may be peeled away after the ink assumes the solid stage." Since Hubbard does not disclose the application of an adhesive to a release sheet having ink in the liquid state on it, claims 3, 7, 8, 10-12, and 15 are non-obvious and should be allowed. (Claim 16 has been withdrawn.)

Claims 6, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stahl (U.S. Patent No. 5,667,614) in view of Abstract of CA 739923, and in further view of Lion (U.S. Patent No. 6,224,707) and Sorkoram (U.S. Patent No. 4,851,061.)

Again, as set forth above, Stahl and the Abstract of CA 739923 may not be combined together to establish a prima facie case of obviousness. Moreover, amended Claim

1 from which claims 6, 9, and 13 depend is further distinguished from Stahl and the Abstract by the incorporation of the limitation "wherein the release sheet may be peeled away after the ink assumes the solid stage." Since neither Lion nor Sorkoram disclose the application of an adhesive to a release sheet having ink in the liquid state on it, claims 6, 9, and 13 are non-obvious and should be allowed.

Conclusion

Applicant has made a genuine effort to respond to each of the Examiner's objections and rejections in advancing the prosecution of this case. Applicant believes that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If any additional issues need to be resolved, the Examiner is invited to contact the undersigned at his earliest convenience.

A check in the amount of \$110.00 is enclosed to cover the one-month Petition fee. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978 -- a duplicate of this paper is enclosed for that purpose.

Respectfully submitted,

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